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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,572	02/04/2004	Daniel Ebi	09307.0019	3718
21127 7590 08/20/2008 RISSMAN JOBSE HENDRICKS & OLIVERIO, LLP 100 Cambridge Street Suite 2101 BOSTON, MA 02114				
EXAMINER				
LEWIS, RALPH A				
ART UNIT		PAPER NUMBER		
3732				
MAIL DATE		DELIVERY MODE		
08/20/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



### Office Action Summary

**Application No.**

10/771,572

**Applicant(s)**

EBI ET AL.

**Examiner**

Ralph A. Lewis

**Art Unit**

3732

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 7, 8, 12-15, 17-21, 23-30 and 32-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 8, 12-15, 17-21, 23, 24, 26-30 and 32-34 is/are rejected.
- 7) ☒ Claim(s) 25 and 35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_



## Rejections based on Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

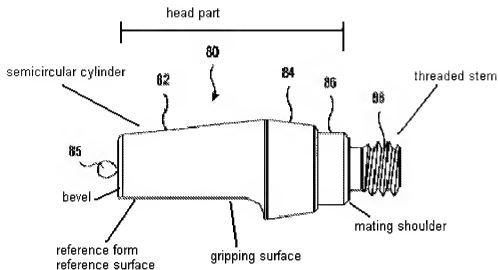
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7, 8, 12, 13, 15 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Porter et al (US 6,758,672).

Porter et al disclose an extension piece 80 for a dental implant 10. The Porter et al extension piece includes a head part 82 and threaded stem 88. The extension piece 80 includes a reference surface 87 that defines the circumferential position of the extension piece. The left portion of the surface 87 in Figure 4d meets the "reference form" limitation and the right portion of surface 87 in the Figure is capable of being gripped for screwing in the extension piece 80, thus meeting the "gripping surfaces" limitation. In regard to claim 3, see the first contour 202 in the embodiment of Figure 12 which is between the identified gripping surfaces and reference form. Note further Figure 4a of Porter et al reproduced and labeled below:





In regard to claim 8, note the transfer aid 94 (Figure 5a) of Porter et al having transfer surface 99, a base plate 91, a circular lip (not shown) having a second contour to match first contour 202 of the Figure 12 embodiment and a recess 96 in the transition area between the transfer surface and the semi cylindrical inner surface.

In response to the present rejection, applicant specified that the claimed bevel is "in the area" of the transition from the reference surface to the semicircular outer circumferential surface of the semicircular cylinder. The examiner is of the position that the bevel identified above is "in the area" of where the reference surface meets the semicircular cylinder surface. Applicant further asserts that the identified bevel is not a "bevel," but rather a "curvature." The examiner notes that applicant points to no definition requiring that the term "bevel" have a flat surface, nor has applicant chosen to put such a limitation in the claims. Finally, applicants argue that their bevel has a different function than that of applicants. The examiner notes that the intended function



isn't even in the claim and that even if it were it would do little in overcoming a 103 rejection.

Applicant is encouraged to provide in the claims clear structural distinctions between the claimed device and the prior art.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Porter et al (US 6,758,672).

In regard to claim 26, the selection of conventional dental materials for the dental extension piece of Porter et al would have been obvious to one of ordinary skill in the art as a matter of routine in practicing the Porter et al invention.

Claims 14, 17-21, 23, 24, 27, 29, 30 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porter et al (US 6,758,672) in view of Gittleman (US 6,508,650).

In regard to claim 14, Gittleman teaches the use of holes 70 in the transfer aid in order to allow for a secure attachment with the impression material. To have added similar holes to the base of the Porter et al impression aid 94 in order to provide for a



secure attachment with the impression material would have been obvious to one of ordinary skill in the art in view of the teaching by Gittleman.

In regard to claims 17 and 29, Porter et al disclose step (a) the screwing of extension piece 80 into implant 10 at Fig 4d and step (b) producing an impression by applying impression compound wherein the extension piece remains connected with the implant when the impression material is removed (column 5, lines 31-40). Porter et al disclose a variation of steps (c)-(f). In Porter et al the extension piece 80 is initially left in the implant after the impression is made and an extension piece/implant analog 120 (manipulation implant) is positioned in the correct position of the impression (column 5, lines 49-55). A working model is made from the impression with the implant analog (column 5, lines 60-62). A preparation coping 150 ("a position marking") is prepped on the model. The extension piece 80 is removed from the implant, the impression coping 150 (position marking) is arranged on the extension piece and the extension piece 80 is then machined (column 6, lines 50-54). The Porter et al method differs from that presently claimed in that Porter et al use an analog (or duplicate) extension piece/implant 120 for the creation of the working model rather than the original extension piece with an implant analog.

Gittleman, however, teaches in his background of the invention that it is known to use the original extension piece ("transfer post") which is attached to the implant analog ("manipulation implant") (note column 1, lines 46-50) rather than an analog extension piece as taught by Porter et al. To have merely used the original extension piece 80 of Porter et al for making the working model rather than an extension piece analog 120 as



was known in the art as evidenced by Gittleman would have been obvious to one of ordinary skill in the art. In regard to the torque limitations, it would have been obvious as matter of routine to secure the extension piece tightly to the implant in order to get an accurate impression.

#### **Allowable Subject Matter**

Claims 25 and 35 are objected to as being dependent on rejected base claims but would be allowable if rewritten in independent form to include all of the limitations of the claims from which they depend.

#### **Action Made Final**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (571) 273-8300. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Cris Rodriguez, can be reached at (571) 272-4964.

R.Lewis  
August 18, 2008

/Ralph A. Lewis/

Primary Examiner, Art Unit 3732